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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/997,122   | 11/28/2001  | Michael W. Johnson   | 80113.0230          | 3626             |
| 20480  | 7590        | 11/13/2003           | EXAMINER            |                  |
| STEVEN L. NICHOLS<br>RADER, FISHMAN & GRAVER PLLC<br>10653 S. RIVER FRONT PARKWAY<br>SUITE 150<br>SOUTH JORDAN, UT 84095 |             |                      | LABAZE, EDWYN       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2876                |                  |
| DATE MAILED: 11/13/2003  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,122

Applicant(s)

JOHNSON, MICHAEL W.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 01 August 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 and 27-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 8/01/2003.
2. Claims 1-19 and 27-31 are presented for examination. Claims 20-26 were redrawn from election/restriction (see Election/Restriction 6/30/2003).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Fiset (U.S. 5,589,719).

Re claim 1: Fiset discloses card out of socket detector for IC cards, which includes an IC (smart) card 1202 [see figs. # 1 and 12 of Fiset] comprising of processing and memory circuitry 1240 (col.13, lines 56-67; col.14, lines 20+); an interface 1212 for electrically connecting the smart (IC) card to a host device 1201, the interface comprising a power line for receiving power from the host device (col.13, lines 38+); a primary battery 1213 disposed in the smart (IC) card for providing power to the processing and memory circuitry (col.13, lines 43+); and a secondary rechargeable battery 1214 disposed in the smart (IC) card for providing power to the processing and memory circuitry (col.13, lines 44+); and recharging circuitry for recharging the secondary battery with power from the host device (col.6, lines 24+).

Re claim 3: Fiset teaches an IC card, wherein the primary battery 1213 is a lithium battery (col.9, lines 5+).

Re claim 4: Fiset discloses an IC card, further comprising means for preventing [through bipolar transistors Q200, Q201, Q202] the primary and secondary batteries from charging each other (col.6, lines 20+).

Re claim 5: Fiset teaches an IC card, further comprising a first diode D3 preventing discharge of the second battery into the primary battery (col.6, lines 40+).

Re claim 6: Fiset discloses an IC card, further comprises a second diode D4 preventing discharge of the first battery into the second battery (col.6, lines 45+).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 8-14, 16-19, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiset (U.S. 5,589,719) in view of Yoshimura (U.S. 5,650,974).

The teachings of Fiset have been discussed above.

Fiset fails to teach a non-rechargeable primary battery.

Yoshimura teaches semiconductor memory device and power supply control IC for use with semiconductor memory device, which includes a non-rechargeable primary battery BAT1 (See Figs. # 1-3, 7-9 of Yoshimura; col.2, lines 3+; col.8, lines 55+).

In view of Fiset's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Fiset a primary non-rechargeable battery for holding a constant voltage throughout the lifetime of the battery when powering the memory of the card. Furthermore, the use of a non-rechargeable battery is advantageous for the memory and prevents any possible surcharge or excessive voltage to the memory when the card is being excited [in contact] with the host device. Moreover, such modification would have an obvious extension of the teachings of Fiset, therefore an obvious expedient.

Re claims 9 and 28: Fiset teaches an IC card, wherein the primary battery 1213 is a lithium battery (col.9, lines 5+).

Re claims 10 and 17: Fiset as modified by Yoshimura discloses an apparatus, further comprising installing the smart/IC card 1201 in a host device 1201 (See Fig. # 12 of Fiset); electrically connecting the smart card 1202 to the host device 1201 and providing power [from the power supply 1204] to the smart/IC card 1202 from the host device 1201 (col.13, lines 30+); and charging the secondary battery with power from the host device (col.13, lines 50+).

Re claims 11 and 18: Fiset as modified by Yoshimura teaches an apparatus, further comprising providing power to the processor and memory circuitry 1240 with the second battery 1214 when the card 1202 is removed from the host device 1201 (col.14, lines 10+).

Re claims 12, 19 and 29: Fiset as modified by Yoshimura discloses an apparatus, further comprising charging the secondary battery 1214 prior to installation of the smart/IC card 1202 in a host device 1201 (col.6, lines 24+), and powering the processing and memory circuitry 1240 with the secondary battery 1214 after depletion of the second battery [by using a non-

rechargeable battery as modified above in claim 2, and after the lifetime of the primary battery runs out, the supportive power of the memory is then supplied by the secondary rechargeable battery using the booster] (col.11, lines 20-67 ; col.12, lines 1-67).

Re claim 13: Fiset as modified by Yoshimura teaches an apparatus, further comprising preventing discharge of said secondary battery into said primary battery (col.6, lines 40+).

Re claim 14: Fiset as modified by Yoshimura discloses an IC card, further comprises preventing discharge [through a second diode D4] of the first/primary battery into the second battery (col.6, lines 45+).

Re claim 30: Fiset as modified by Yoshimura teaches an apparatus, further comprising preventing discharge of said secondary battery into said primary battery (col.6, lines 40+); and preventing discharge [through a second diode D4] of the first/primary battery into the second battery (col.6, lines 45+).

7. Claims 7, 15 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiset (U.S. 5,589,719).

The teachings of Fiset have been discussed above. Fiset further teaches an IC card 1202 with a large block of memory and could be used in a variety of devices (col.13, lines 55+).

Fiset fails to teach/suggest that the card comprises access control data for a cable television system stored in the processing and memory circuitry.

However, since the card is required to store various types of data and designed to meet most industry interfaces/system, the specific structure with control data for a cable television system is obtained and falls within the engineering design choice.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Fiset the access control data for a cable television system stored in the processing and memory circuitry in order to be able to use the card in set-top box system. Furthermore, various information (such as personal and/or credit card information, wherein the card is debited by the cable company for a paying-per-view system) could be loaded/written onto the card and provide data to the set-top box to permit appropriate reproduction on the output device. Moreover, such modification would have been an obvious extension as taught by Fiset, therefore an obvious expedient.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-19 and 27-31 filed on 8/01/2003 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bridgelall et al. (U.S. 6,415,982) discloses triggered data collector and data transmitter.

Goldstein et al. (U.S. 6,565,232) teaches apparatus having magnifying illuminating and mirroring attributes.

Toshiatsu (JP 361160185) discloses IC card including battery.

Osamu (JP 406124370) teaches memory card and its manufacturing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
October 27, 2003



DIANE I. LEE  
PRIMARY EXAMINER